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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of : **Confirmation No. 8571**
Franz SIEBERER : Attorney Docket No. 2004_0129A
Serial No.10/773,275 : Group Art Unit 3679
Filed February 9, 2004 : Examiner Ernesto Garcia
TRANSPORT SECURING ARRANGEMENT : **Mail Stop: APPEAL BRIEF-PATENTS**

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated November 2, 2006. Entry of this Reply Brief is respectfully requested.

Initially, regarding the Examiner's Answer dated November 2, 2006, Appellant notes that a new grounds of rejection was contained therein for claim 6, which requires the personal approval of a Technology Center Director. The Examiner's Answer dated November 2, 2006, however, did not include the signature of the Technology Center Director (i.e., Donald T. Hajec). In addition, in a supplemental communication from the PTO dated December 19, 2006, although the Examiner indicates therein that the Technology Center Director has signed the Examiner's Answer, the copy of the signature page provided therewith once again does not include the signature of Technology Center Director (i.e., Donald T. Hajec).

Accordingly, as the Technology Center Director has not personally approved the new ground of rejection for claim 6 in the Examiner's Answer, Appellant submits that such a rejection is improper.

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Furthermore, Appellant notes that in the Examiner's Answer, the Examiner has introduced a new grounds of rejection for claim 8. In particular, in the Advisory Action dated January 10, 2006, the Examiner clearly indicated that claims 1-7 and 9 are rejected, and that claim 8 is merely objected to (see item 7 of the Advisory Action). Thus, as indicated in the Status of Claims section of the Appeal Brief dated May 11, 2006, claims 1-7 and 9 are finally rejected, and claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

In the Examiner's Answer, however, the Examiner has rejected claim 8 under 35 U.S.C. § 102(b) as being anticipated by EP 0 694 460. As clearly set forth in the MPEP, this rejection is improper and cannot be presented in the Examiner's Answer. In particular, as explained in MPEP §1207.03(II), a "new ground of rejection would not be permitted to reject a previously allowed or objected to claim even if the new ground for rejection would rely on evidence already of record" (emphasis added).

Therefore, as the Examiner indicated in the Advisory Action that claim 8 is not rejected, but is merely objected to (i.e., contains allowable subject matter), Appellant submits that the Examiner's rejection of claim 8 in the Examiner's Answer is clearly improper in view of the guidelines set forth in the MPEP.

STATUS OF CLAIMS

Claims 1-9 stand finally rejected. The rejections of claims 1-9 are being appealed.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-5, 8 and 9 were rejected under 35 U.S.C. § 102(b) as being anticipated by EP 0 694 460.

2. Claims 1, 4 and 7 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. 4,943,181 to Murphy.

3. Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 0 694 460 in view of U.S. 3,789,638 to Roberts et al.

ARGUMENT

I. Response to Examiner's comments in the Examiner's Answer

A. Rejection of claims 1-5, 8 and 9 under 35 U.S.C. § 102(b) as being anticipated by EP 0 694 460 (hereinafter "the '460 reference")

Claim 1 is drawn to a transport securing arrangement for a side extension arm of a vehicle, the transport securing arrangement including a locking device and a securing hook, wherein the locking device and the securing hook are arranged such that both the locking device and the securing hook are operable to act on the side extension arm.

In the Final Office Action, the Examiner took the position that the above-noted feature drawn to the locking device and the securing hook being "arranged such that both the locking device and the securing hook are operable to act on the side extension arm" is a "mere abstract idea" to which no structure can be associated (see Final Office Action at page 7). In the Examiner's Answer, the Examiner has taken a similar position by suggesting that the above-noted feature is merely an intended use of the device and that no interaction of the locking device and the securing hook with the side extension arm is recited (see Examiner's Answer at page 7). Appellant disagrees.

In particular, Appellant submits that the above-note feature defines the structural arrangement of the locking device and securing hook in relation to the extension arm, wherein the structural arrangement of the locking device and securing hook enable these elements to function so as to act on the side extension arm of the vehicle. Thus, according to claim 1, because the locking device and securing hook must be arranged as part of the claimed apparatus such that they are operable to act on the side extension arm of the vehicle, Appellant submits that such a feature is not a "mere abstract idea" and that the arrangement of the locking device and the securing hook which enables such elements to be operable to act on the side extension arm of the vehicle is not a mere intended use.

Appellant notes that the MPEP specifically points out that there is nothing intrinsically wrong in defining something by what it does rather than by what it is. In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981). A functional limitation must be evaluated and

considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. See MPEP §2173.05(g).

Furthermore, in the Examiner's Answer, the Examiner indicates that the rejection of claim 1 "could have been obviated by positively reciting the extension arm as part of the transport securing arrangement and positively interacting the locking device and the securing hook with the extension arm" (see the Examiner's Answer at page 7). Thus, as clearly evidenced by this statement by the Examiner, if the interaction of the locking device and the securing hook with the extension arm (i.e., the locking device and securing hook being arranged so as to be operable to act on the side extension arm) is given patentable weight, then the Examiner agrees that the rejection of record would be withdrawn.

In this regard, for the reasons discussed above, Appellant submits that the interaction of the locking device and securing hook with the side extension arm (i.e., that the locking device and securing hook are arranged so as to be operable to act on the side extension arm) should clearly be given patentable weight, and that the Examiner's position that the claimed feature is a mere "abstract idea" and "intended use" is clearly improper.

Further, in the Examiner's Answer, the Examiner has indicated that the "device of Markus '460 is operable to 'act on' the side extension arm 1 in that by operating the locking device 11 and the securing hook 10, the side extension arm 1 is 'acted on' thus enabling retraction or extension of the side extension arm" (see the Examiner's Answer at the sentence bridging pages 7 and 8). Based on this comment by the Examiner, the Examiner is apparently under the impression that the detent member 11 and the end portion 10 of the lever 3 are used to enable and disable retraction and extension of the beam 1. Appellant disagrees with the Examiner's position and submits that the Examiner has misunderstood the operation of the device as disclosed in the '460 reference.

In particular, in the '460 reference, Appellant notes that this reference discloses a horizontal beam 1 which is displaceable in a housing 2 (see Figs. 2a-2c). As shown in Fig. 2c of the '460 reference, a rotatable lever 3 is attached to the beam 1, wherein a claw 4 is provided on the lever 3. When the beam 1 is not secured in a closed position (i.e., when the beam 1 is not

locked inside the housing 2), the rotatable lever 3 projects over the end of the beam 1, thereby acting as a signal that the beam 1 is not secured in the locked position (see the Abstract; and Figs. 2c and 3c).

As shown in Fig. 3c of the '460 reference, a detent member 11, which is attached to the beam 1, operates so as to fix the lever 3 in the downward position (i.e., the signaling position) by engaging an end portion 10 of the lever 3 (see the Abstract). As shown in Fig. 3b, by moving the beam 1 toward the housing 2, the detent member 11 engages a protrusion 12 on the housing 2, thereby releasing the end portion 10 of the lever 3 from the detent member 11 (see Fig. 3b).

Thus, contrary to the position taken by the Examiner, while the detent member 11 is able to engage the end portion 10 of the lever 3 so as to maintain the lever 3 in the signaling position, the interaction between the detent member 11 and the end portion 10 of the lever 3 does not enable or disable the retraction or extension of the beam 1.

For example, as shown in Fig. 3c, the detent member 11 engages the end portion 10 of the lever 3 so as to maintain the lever 3 in the signaling position such that the lever can be seen by an operator. Upon inward movement of the beam 1, as shown in Fig. 3b, the detent member 11 engages the unlocking member 12, which enables the lever to be pivoted upward. Thus, as is clearly evident from Figs. 3b and 3c of the '460 reference, the Examiner is incorrect in stating that the interaction between the detent member 11 and the end portion 10 of the lever 3 enables retraction or extension of the beam 1.

As noted above, claim 1 is drawn to a transport securing arrangement for a side extension arm of a vehicle, wherein a locking device and a securing hook are arranged such that both the locking device and the securing hook are operable to act on the side extension arm.

In particular, as discussed above, both the detent member 11 and the end portion 10 of the lever lever 3 are attached to the beam 1 (see Fig. 2c and Fig. 3c). Accordingly, as the detent member 11 and the lever 3 are attached to the beam 1, it is clear that the detent member 11 and the end portion 10 of the lever 3 are not operable to act on the beam.

In this regard, while the detent member 11 may arguably be arranged so as to "act on" the end portion 10 of the lever 3, Appellant submits that the detent member 11 itself is not operable

to act on the beam 1. Similarly, while the end portion 10 of the lever 3 is used in conjunction with the detent member 11 to secure the lever 3 in the signaling position (i.e., the position shown in Fig. 3c), the end portion 10 of the lever 3 is also clearly not operable to act on the beam 1.

In view of the foregoing, Appellant submits that the '460 reference does not disclose, suggest or otherwise render obvious the feature of the locking device and securing hook being arranged such that both the locking device and the securing hook are operable to act on the side extension arm. Accordingly, Appellant submits that claim 1 is patentable over the '460 reference.

Claims 2-5, 8 and 9 depend from claim 1 and are therefore considered patentable at least by virtue of their dependency.

B. Rejection of claims 1, 4 and 7 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,870,467 to Murphy (hereinafter "Murphy")

As noted above, claim 1 is drawn to a transport securing arrangement for a side extension arm of a vehicle, wherein a locking device and a securing hook are arranged such that both the locking device and the securing hook are operable to act on the side extension arm. Appellant submits that Murphy does not disclose such a feature.

Regarding the Murphy reference, Appellant notes that this reference discloses a locking quick disconnect device 10 that is used to lock a tooling attachment 14 to a boom 12 (see Fig. 1; col. 2, line 66 through col. 3, line 4; and col. 4, lines 30-33). In Murphy, the locking quick disconnect device 10 is provided in a housing member 11, wherein the housing member 11 includes side walls 33a and 33b, a first end wall 34, and a longitudinal wall 35 (see Fig. 3 and col. 3, lines 5-10).

As explained in Murphy, within the housing member 11 is provided a cam arrangement 15 and a locking member 13, wherein the cam arrangement 15 and the locking member 13 of the locking quick disconnect device 10 can engage and disengage with one another so as to lock and unlock the tooling attachment 14 to/from the boom 12 (see Figs. 1, 4 and 5; and col. 4, lines 25-40).

As noted above, claim 1 is drawn to a transport securing arrangement for a side extension arm of a vehicle, wherein a locking device and a securing hook are arranged such that both the locking device and the securing hook are operable to act on the side extension arm.

In the Examiner's Answer, the Examiner has taken the position that in Murphy, the cam arrangement 15 corresponds to the "locking device" of claim 1, that the locking member 13 corresponds to the "securing hook" of claim 1, and that the housing member 11 corresponds to the "side extension arm" as recited in claim 1 (see Examiner's Answer at pages 5 and 8).

Initially, Appellant submits that the Examiner's position that the housing member 11 of Murphy corresponds to a "side extension arm" is unreasonable. For example, as discussed above, the housing member 11 of Murphy includes walls 33a, 33b, 34 and 35, and is used to house a portion of the cam arrangement 15 and the locking member 13 therein, wherein the cam arrangement 15 and the locking member 13 can engage and disengage with one another so as to lock and unlock the tooling attachment 14 to/from the boom 12 (see Fig. 1).

Thus, as the housing member 11 of Murphy is merely a structure that is used to house a portion of the cam arrangement 15 and the locking member 13 therein, Appellant submits that the housing member 11 cannot reasonably be considered to be a "side extension arm" as recited in claim 1, and certainly cannot be considered to be a "side extension arm of a vehicle" as recited in claim 1.

Further, based on the above-noted correspondence between elements in Murphy and the elements recited in claim 1, the Examiner is alleging that the cam arrangement 15 and the locking member 13 are arranged such that both the cam arrangement 15 and the locking member 13 are operable to act on the housing 11. Appellant disagrees.

In particular, Appellant notes while parts of the cam arrangement 15 and the locking member 13 are disposed within the housing member 11, that the cam arrangement 15 and locking member 13 are in no way whatsoever arranged so as to be operable to act on the housing member 11. In this regard, Appellant notes that the Examiner has not provided any explanation in the Examiner's Answer as to how the cam arrangement 15 and locking member 13 could possibly be considered to "act on" the housing member 11.

In view of the foregoing, Appellant submits that Murphy does not disclose, suggest or otherwise render obvious the feature of the locking device and securing hook being arranged such that both the locking device and the securing hook are operable to act on the side extension arm, as recited in claim 1. Accordingly, Appellant submits that claim 1 is patentable over Murphy.

Claims 4 and 7 depend from claim 1 and are therefore considered patentable at least by virtue of their dependency.

II. New Grounds of Rejection

Rejection of claim 6 under 35 U.S.C. § 103(a) as being unpatentable over EP 0 694 460 in view of U.S. 3,789,638 to Roberts et al. (hereinafter “Roberts”)

Claim 6 depends from claim 1. Appellant submits that Roberts fails to cure the deficiencies of the ‘460 reference, as discussed above, with respect to claim 1. Accordingly, Appellant submits that claim 6 is patentable at least by virtue of its dependency.

In addition, Appellant notes that claim 6 recites that the release of the locking device is independent of a direction of rotation of the locking device. In the Examiner’s Answer, the Examiner recognizes that the ‘460 reference does not disclose or suggest such a feature. The Examiner, however, takes the position that the Roberts reference would suggest to one of ordinary skill in the art to modify the locking device of the ‘460 reference such that the release of the locking device is independent of a direction of rotation. Appellant disagrees.

As is well known, in order to establish a *prima facie* case of obviousness, (1) the combination of prior art references must teach or suggest all of the claim limitations; and (2) there must be some suggestion or motivation to combine the references in the manner suggested to obtain the claimed invention. See MPEP Chapter 2143. As will be explained in detail below, there is clearly no suggestion, either in the references themselves or in the knowledge of those of ordinary skill in the art, to combine the references in the manner suggested by the Examiner.

As noted above, the Examiner has taken the position that the detent member 11 of the '460 reference corresponds to the "locking device" as claimed. Regarding the detent member 11, Appellant notes that while the detent member 11 is rotated in a clockwise direction upon its engagement with the protrusion 12 so as to be released from the end portion 10 of the lever 3, the release of the detent member 11 from the end portion 10 of the lever 3 is clearly not independent of the direction of rotation of the detent member 11 (see Fig. 3b).

Regarding the Roberts reference, Appellant notes that this reference discloses a rotary disc tumbler lock in which a key 26 can be inserted into the lock and rotated in either direction so as to operate the tumblers (see the Abstract and col. 3, lines 51-56). Thus, while this reference discloses that the user of a key can turn the key in either a clockwise direction or a counterclockwise direction in order to operate the tumblers, Appellant submits that such disclosure would not in any way whatsoever suggest to one of ordinary skill in the art that the detent member 11 of the '460 reference should be modified such that the release of the detent member 11 from the end portion 10 of the lever 3 is independent of a direction of rotation of the detent member 11.

In the Examiner's Answer, the Examiner has indicated that it would have been obvious to modify the detent member 11 of the '460 reference such that the release of the detent member 11 from the end portion 10 of the lever 3 is independent of a direction of rotation of the detent member 11 "so that either turning the device clockwise or counterclockwise the locking device becomes released" (see the Examiner's answer at the top of page 7). Appellant disagrees with the Examiner and submits that this motivation is conclusory and does not in any way whatsoever explain why one of ordinary skill in the art would modify the detent member 11 of the '460 reference such that the release of the detent member 11 is independent of a direction of rotation.

Indeed, as clearly shown in Figs. 3b and 3c of the '460 reference, the detent member 11 is arranged such that it engages the unlocking member 12 upon the beam 1 being inserted into the housing 2, whereby upon engagement of the detent member 11 and the unlocking member 12, the detent member pivots in a clockwise direction so as to release the detent member 11 from the end portion 10 of the rotatable lever 3.

Thus, in the '460 reference, the detent member 11 can only be rotated in a single direction upon engagement with the unlocking member 12, and because the detent member is not being rotated by a user, as is the key in the Roberts reference, Appellant submits that one of ordinary skill in the art would have no reason to modify the detent member 11 of the '460 reference such that it could be released independent of a direction of rotation. Further, the Examiner has not explained how such a construction would be accomplished in the '460 reference. In particular, Appellant submits that there is only one unlocking member 12 in the '460 reference, wherein this unlocking member 12 is clearly a stationary element, and that the single unlocking member 12 alone would clearly not be able to release the detent member 11 from the end portion 10 of the lever independent of a direction of rotation of the detent member 11.

In view of the foregoing, Appellant submits that one of ordinary skill in the art would not have been motivated, based on the disclosure of Roberts, to modify the '460 reference such that the detent member 11 could be released from the end portion 10 of the lever 3 independent of a direction of rotation of the detent member 11.

Accordingly, Appellant submits that the above-noted feature in claim 6 which recites that the release of the locking device is independent of a direction of rotation of the locking device is not obvious in view of the combination of references cited by the Examiner. Accordingly, Appellant submits that claim 6 is patentable over the applied prior art, an indication of which is kindly requested.

III. Conclusion

For the reasons set forth above, as well as the reasons set forth in Appellant's Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on appeal. A favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

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